

APR 22 2004
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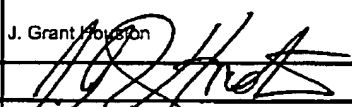
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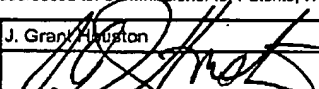
TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/885,226	
	Filing Date	June 20, 2001	
	First Named Inventor	Robert L. Payer	
	Art Unit	2839	
	Examiner Name	Patel, Tulsidas C.	
Total Number of Pages in This Submission	8	Attorney Docket Number	1065.us

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request for Withdrawal of Final Action, Documentation of Newly Cited Reference, and Supplemental Applicant's Brief
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	J. Grant Houston
Signature	
Date	April 23, 2004

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Typed or printed	J. Grant Houston		
Signature		Date	April 22, 2004

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APR 22 2004

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In Re: Robert L. Payer, *et al.*

Serial No: 09/885,226

Group: 2839

Filed: June 20, 2001

Examiner: Patel, Tulsidas C.

For: Solid-Phase Welded Optical
Element Attach Process

Confirmation No: 4417

Date: April 22, 2004

1) REQUEST FOR WITHDRAWAL OF FINAL ACTION
2) DOCUMENTATION OF NEWLY CITED REFERENCE AND
3) SUPPLEMENTAL APPELLANTS' BRIEF

VIA FACSIMILE: 703-872-9306
Mail Stop Appeal Brief- Patents
Assistant Commissioner for Patents
P.O. Box 1450,
Alexandria, Virginia 22313-1450

Sir:

This is a request to withdraw the finality of the pending Office Action, request to have a newly-cited prior reference to be made a part of this application's file wrapper, and a Supplemental Appellants' Brief to reinstate the appeal of this application.

Procedural Posture

In response to the first final Office Action (hereinafter First Final Office Action), mailed March 28, 2003, Applicants filed a Notice of Appeal on August 28, 2003. Then, subsequently, on December 28, 2003, the Applicants filed an Appellants' Brief.

On January 23, 2004, a new "final" Office Action was issued (hereinafter Second Final Office Action). This Second Final Office Action indicated that some claims were allowed and indicated the allowability of other objected to claims. On the other hand, the new rejections were made on a number of claims including rejections based on a newly cited reference.

1) Request for Withdrawal of the Finality of Second Final Office Action

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In order to clarify and ensure the accuracy of the procedural posture of the instant application, Applicants hereby request withdrawal of the finality of the Second Final Office Action, mailed January 23, 2004, because 1) new rejections were made and 2) a new reference was cited.

In more detail, in a number of instances, the Second Final Office Action made new rejections of claims. Specifically, claim 6 was newly rejected as anticipated by U.S. Pat. No. 5,841,544 to Dautartas, *et al.* (hereinafter Dautartas patent). Further, claims 14, 15, 19, and 23 were newly rejected under 35 U.S.C. 103(a) as being unpatentable over the Dautartas patent, in view of a PCT application, International Publication No. WO 91/16022 to Koolit Intellectual Properties, Pty. Limited (hereinafter Koolit Application). Moreover, claims 16, 17, 22, and 24-26 were rejected as being unpatentable over the Dautartus patent, Koolit Application, and the U.S. Pat. No. 5,888,841 to Snyder (hereinafter Snyder patent). Each of these rejections was new to the Second Final Office Action. Moreover, the Koolit Application had never been cited in the instant application.

An attempt to justify the finality of the Second Final Office Action was made on its page 6, ¶12. There it is stated that "Applicant's amendment necessitated the new ground(s) of rejection..." This position is not valid, however. No amendments were pending at the time of the Second Final Office Action.

Moreover, it seems unfair to raise entirely new rejections, based on previously uncited prior art references in a final Office Action.

Thus, Applicants respectfully request withdrawal of the finality of the Second Final Office Action.

2) Documentation of Newly Cited Reference to Complete File wrapper

The second Final Office Action applied the Koolit application to a number of the claims. This piece of prior art, however, had not been previously cited in connection with the instant application. That is, no form PTO-892 was issued.

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In order to ensure the completeness of this application's record, a PTO-1449 is being submitted herewith. It is requested that this reference be made part of the record of the instant application by the entrance of this PTO-1449.

A separate information disclosure statement or fee is not being submitted since this reference was cited by the Examiner.

3) Supplemental Brief

This Supplemental Brief is further to the Appellants' Brief, which was filed on November 28, 2003. Only those sections that have been modified are included herein. That is, the sections Real Party in Interest, Related Appeals and Interferences, Status of Amendments, Summary of Invention, and Grouping of Claims remain the same.

Status of Claims

Claims 1-34 are pending in this application. Claims 27-34 are withdrawn from consideration. Claims 7 and 20 have been allowed. Claims 5, 8, 18, and 21 have merely been objected to as depending from rejected base claims. Claims 1-4, 6, 9-17, 19, and 22-26 stand finally rejected.

Issues

- 1) Whether claims 1, 2, and 6 are anticipated under 35 U.S.C. § 102(b) as being anticipated by the Dautartas patent.
2. Whether claims 3, 4, and 9-13 are unpatentable over the Dautartas patent in view of the Snyder patent.
- 3) Whether claims 14, 15, 19 and 23 are unpatentable over the Dautartas patent in view of the Koolit application.
- 4) Finally, whether claims 16, 17, 22, and 24-26 are unpatentable over the Dautartus patent and the Koolit application in further view of the Snyder patent.

Argument

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In this argument section, only the new rejections will be addressed. Attention is directed to Appellants earlier Brief and the responses therein to the rejections to the extent that they remain the same as in the First Final Office Action.

Claim 6 was newly rejected as being anticipated by the Dautartus patent in the Second Final Office Action. Claim 6 requires three elements: 1) an optical element; 2) a mounting structure; and 3) an optical bench, the mounting structure attaching the optical element to the optical bench.

The Dautartus patent, as applied against claim 6, only shows two of the three claimed elements. Specifically, the Dautartus lens 32 is analogized to the claimed optical element. The claimed mounting structure is analogized to the Dautartus platform 12. Claim 6, however, further requires an optical bench. According to the formulated rejection, the Dautartus patent does not have a component that corresponds to the claimed optical bench. Thus, there is no anticipation.

Claim 6 further requires that the optical element is a microelectromechanical device.

The Dautartus lens 32 is not a microelectromechanical device. The Office Action argues that the Dautartus lens 32 meets this limitation. A lens, while being an optical device, is not an electromechanical device, as claimed.

Thus, for this further reason, there is no anticipation.

Claims 14, 15, 19, and 23 were newly rejected as being unpatentable over the Dautartus patent in view of the Koolit application. It was argued that the Koolit application "discloses a mounting structure for an optical element and the mounting structure 1 is soldered to the bench 10.

In fact, the Koolit application is directed to a cooling device. It is not clear which part of the application is deemed relevant to the instant rejection. Generally, the Koolit application does not disclose anything that would correspond to a mounting structure soldered to the bench, for example.

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Thus, Applicants respectfully request withdrawal of this rejection.

Claims 16, 17, 22, and 24-26 were rejected as being unpatentable over the Dautartus patent, in view of the Koolit application and in further view of the Snyder patent.

As discussed in the previous rejection, however, the teachings ascribed to the Koolit application are not in fact present in that application. Thus, the foundation for this rejection is believed to be flawed. Its withdrawal is, thus, respectfully requested.

In response to the "Response to Arguments", found on page 5 of the Second Final Office Action, Applicants wish to make a few points. Most importantly, the Office Action seemed to attribute confusion to Applicants' statement. It is hope that the following removes any confusion.

Specifically, the Second Final Office Action noted that Applicants stated that "the Dautartus, *et al.* patent does not show or suggest the solid phase welding of an optical element to an optical bench via a mounting structure". Then Examiner pointed out that claim 1 recites an "optical element solid phase welded to the mounting structure". The Second Final Office Action then expressed confusion because "it is the optical element and the mounting structure that are solid phase welded and not the optical element and the optical bench". The basis for the confusion is unclear. These statements are all consistent with each other. Clarification concerning the basis for Examiner's confusion is requested.

Applicants' position is that claim 1, for example, requires three components: an optical element, a bench, and a mounting structure for connecting the element to the bench. In contradistinction, the Dautartus patent shows a system in which the optical element, ball lens, is directly bonded to the bench, platform.

For the forgoing reasons, Applicant continues to take the position that the pending rejections should be withdrawn. In any case, Applicants respectfully request the immediate review by the Board of Patent Appeals and Interferences.

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Should any questions arise, please contact the undersigned.

Respectfully submitted,

By 

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